

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte JASHAWANT J. MODI

MAILED

Appeal No. 2001-2397
Application No. 08/855,779

APR 18 2003

ON BRIEF

**PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES**

Before WINTERS, MILLS, and GRIMES, Administrative Patent Judges.

GRIMES, Administrative Patent Judge.

1615

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-44, all of the claims in the application. Claims 1, 4, and 12 are representative and read as follows:

1. A personal care composition comprising:
 - (a) from about 0.1% to about 99% by weight of a vehicle system which comprises a hydrophobically modified nonionic water soluble polysaccharide polymer having a hydrophilic portion which comprises a water soluble polysaccharide polymer backbone and a hydrophobic moiety selected from the group consisting of C₃-C₇ alkyl, aryl alkyl, alkyl aryl groups and mixtures thereof, wherein the ratio of the hydrophilic portion to the hydrophobic portion of the polymer is from about 2:1 to 1000:1, and

- (b) at least one active personal care ingredient.
4. The composition of claim 1 wherein the composition also comprises from about 0.1% to about 99% by weight of the personal care composition of a compatible solvent or solvent mixture.
12. A shampoo comprising an effective amount of the personal care composition of claim 4.

The examiner relies on the following references:

t'Sas	4,845,207	Jul. 04, 1989
Angerer	4,902,733	Feb. 20, 1990
Sau	4,904,772	Feb. 27, 1990

Claims 1-8, 10, and 44 stand rejected under 35 U.S.C. § 102(b) as anticipated by Angerer.

Claims 1-8, 9, and 44 stand rejected under 35 U.S.C. § 102(b) as anticipated by t'Sas.

Claims 1-8 and 44 stand rejected under 35 U.S.C. § 102(b) as anticipated by Sau.

Claims 11-43 stand rejected under 35 U.S.C. § 103 as obvious in view of Sau.

We reverse the rejections for anticipation and vacate the rejection for obviousness.

Background

Nonionic water soluble polysaccharides have been used in personal care products such as shaving creams, shampoos, and skin creams. Specification, page 1. "Also, hydrophobically modified polysaccharides are used in personal

care products. The use of these prior art polysaccharides in personal care products sometimes have [sic] processing difficulties such as compatibility with other ingredients, solubility with certain other ingredients, clarity (when needed) and stability under alkaline conditions." Id. Several patents have also "disclose[d] the use of hydrophobically modified nonionic cellulose ethers . . . [having a] long chain alkyl carbon substitution in the hydrophobe (i.e., 8 to 24 carbons) for use in hair and skin care cosmetics." Id., page 2.

The specification discloses that "hydrophobically modified polysaccharide[s] having a short chain alkyl group in the hydrophobe moiety have various advantageous properties over prior art water soluble polysaccharides and their derivatives in personal care products." Pages 2-3. "The hydrophobically modified hydroxyalkylcellulose of the present invention is an essential ingredient of the vehicle system of personal care products. . . . Another ingredient that may be in the vehicle system is a surfactant that can be either soluble or insoluble in the composition. A compatible solvent may also be used in the vehicle system that can be either a single solvent or a blend of solvents." Specification, pages 4-5.

Personal care products containing the disclosed polysaccharides can also contain "an active personal care component." Specification, page 6. "[W]hen an active personal care ingredient is needed, it must provide some benefit to the user's body." Id. Examples of active personal care ingredients include perfumes, emollients, deodorants, and cleansing agents. See pages 6-7.

Discussion

1. Anticipation

Claim 1, the broadest claim on appeal, is directed to a "personal care composition" comprising a "hydrophobically modified nonionic water soluble polysaccharide" and "at least one active personal care ingredient." The examiner and Appellant appear to agree that an example of the polysaccharide defined in the claims is 3-alkoxy-2-hydroxypropylhydroxyethylcellulose, having an alkyl substituent with 3-7 carbon atoms.

The examiner rejected claim 1, together with certain other claims, as anticipated by any of Angerer, t'Sas, or Sau. He characterized each of the prior art references as disclosing compositions comprising 3-alkoxy-2-hydroxypropylhydroxyethylcellulose, having an alkyl moiety that could be C₃-C₇, together with at least one other ingredient that could be considered a "personal care ingredient." See the Examiner's Answer, pages 3-4. Thus, for example, the examiner characterizes Angerer as disclosing a composition comprising 3-alkoxy-2-hydroxypropylhydroxyethylcellulose, where the alkyl moiety can be a straight or branched chain alkyl group having 6-24 carbon atoms, together with other ingredients that can include a surfactant, a solvent, and/or a pigment (titanium dioxide). Examiner's Answer, page 3.

His reasoning is similar with respect to t'Sas and Sau. In each case, the examiner gave no weight to the preamble language reciting a "personal care composition." The examiner concluded that "[t]he preamble does not carry any patentable weight as the claims are drawn to the compositions." Pages 3 and 4.

"[N]ot unlike a determination of infringement, a determination of anticipation, as well as obviousness, involves two steps. First is construing the claim, . . . followed by, in the case of anticipation or obviousness, a comparison of the construed claim to the prior art." Key Pharms. Inc. v. Hercon Labs. Corp., 161 F.3d 709, 714, 48 USPQ2d 1911, 1915 (Fed. Cir. 1998). In this case, the claims must be construed to determine whether the preamble phrase "personal care composition" is entitled to any weight.

"[It is a] general principle, as well-settled as any in our patent law precedent, that a claim preamble has the import that the claim as a whole suggests for it. In other words, when the claim drafter chooses to use both the preamble and the body to define the subject matter of the claimed invention, the invention so defined, and not some other, is the one the patent protects." Bell Communications Research Inc. v. Vitalink Communications Corp., 55 F.3d 615, 620, 34 USPQ2d 1816, 1820 (Fed. Cir. 1995). "If the claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the claim preamble is 'necessary to give life, meaning, and vitality' to the claim, then the claim preamble should be construed as if in the balance of the claim." Pitney Bowes Inc. v. Hewlett Packard Co., 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-66 (Fed. Cir. 1999).

In this case, we conclude that the preamble phrase "personal care composition" limits the scope of the claimed compositions, and therefore should be construed as if in the body of the claim. The body of the claim recites two components of the claimed composition: a hydrophobically modified

polysaccharide and an “active personal care ingredient.” The specification states that the active personal care ingredient “must provide some benefit to the user’s body.” Page 6. Thus, the preamble’s recitation of a “personal care composition” limits the compositions defined by the claims to those that are appropriate for application to a user’s body. The preamble therefore recites a claim limitation which should be construed as if it appeared in the body of the claims.

None of the prior art references discloses a composition, comprising a hydrophobically modified polysaccharide and other ingredients, that would be appropriate for application to a user’s body. The compositions disclosed by Angerer and Sau are latex paints (see the examples in each patent), while the composition disclosed by t’Sas is a building composition intended as a substitute for concrete (see column 1, lines 1-18; column 2, lines 17-23).

None of the disclosed compositions would appear to be appropriate for application to a user’s body. Therefore, none of them appear to be a “personal care composition,” as required by our interpretation of the claims. “Under 35 U.S.C. § 102, every limitation of a claim must identically appear in a single prior art reference for it to anticipate the claim.” Gechter v. Davidson, 116 F.3d 1454, 1457, 43 USPQ2d 1030, 1032 (Fed. Cir. 1997). Since none of Angerer, t’Sas, or Sau disclose a composition meeting all of the limitations of the claims, as properly construed, the claims are not anticipated by these references. The rejections under 35 U.S.C. § 102(b) are reversed.

2. Obviousness

The examiner rejected claims 11-43 as obvious over Sau. These claims are directed to various specific types of personal care compositions, comprising the composition of claim 1 and a solvent (by virtue of their dependence on claim 4). For example, claim 12 is directed to a "shampoo comprising an effective amount of the personal care composition of claim 4," claim 13 is directed to a "conditioner comprising an effective amount of the personal care composition of claim 4," and so on.

In contrast to his treatment of claim 1, the examiner did consider the preamble of claims 11-43 to limit the claimed compositions. See the Examiner's Answer, page 5: "The patent does not disclose the claimed features like conditioner, shampoo, sun care, shower gel, etc." For this reason, presumably, he did not reject the claims as anticipated. However, he pointed out that Sau teaches the disclosed hydrophobically modified polysaccharides to be "useful as thickeners in shampoos and cosmetics." See Sau, column 10, lines 8-11. The examiner concluded that

it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the compositions in the above listed formulations [i.e., shampoos, conditioners, etc.] as it is well known in the "personal care[]" industry to utilize thickeners, solvents, surfactants. No patentable distinction is seen in the use of an old composition in various personal care formulations, [in the] absence of any evidence of criticality.

Examiner's Answer, page 5. The examiner did not elaborate further on what specific composition(s) would have been rendered obvious by the prior art.

The examiner's explanation does not provide us with an adequate basis for reviewing the rejection. The claims that the examiner rejected as obvious require, in addition to a hydrophobically modified polysaccharide, an "active personal care ingredient," a "solvent," and whatever other components are required by the various preambles ("shampoo," "conditioner," etc.). Yet the only disclosure that the examiner points to in the reference is a suggestion to use a hydrophobically modified polysaccharide as a thickener in cosmetics and shampoos.

The examiner's rationale in support of the rejection does not explain what specific other components (active personal care ingredients, solvents, etc.) would have been obvious to combine with the disclosed polysaccharide, such that the reference would have rendered obvious all of the various compositions recited in claims 11-43. Nor does the examiner rely on other prior art or any other evidence to show that the claimed compositions would have been obvious to a person of ordinary skill in the art, based on the disclosure of Sau. Thus, the examiner's rejection does not provide us with an adequate basis on which to decide whether or not the claimed compositions would have been obvious to a person of ordinary skill in the art at the time they were made.

Upon return of this application, the examiner should consider whether Sau's suggestion to use the disclosed polysaccharides in cosmetics and shampoos, in combination with other prior art disclosures and the knowledge of the ordinary artisan, would have rendered obvious any of the compositions now claimed by Appellant. In considering the obviousness of the claimed

compositions, the examiner should bear in mind the claim construction discussed above. With regard to claims 11-41, we note that the preamble recitation of a "shampoo," "conditioner," etc. limits the claims to compositions that would be useful in the recited capacity. Thus, the preambles of claims 11-41 constitute limitations of the claims that must be considered in comparing the claimed subject matter to the prior art.

We also note that the instant specification discloses that "hair and skin care cosmetics" comprising "hydrophobically modified nonionic cellulose ethers" were known in the prior art. See page 2, lines 1-9. The examiner should, of course, consider the patentability of the instant claims in view of the prior art as a whole. Finally, the examiner's obviousness analysis should not be confined to claims 11-43. These claims are ultimately dependent on claim 1, and a conclusion that a dependent claim is obvious necessitates concluding that the independent claim on which it depends is also obvious. The examiner should consider whether any or all of the pending claims would have been obvious in view of the prior art.

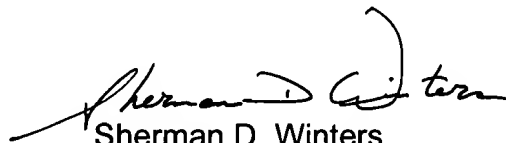
Future Proceedings

We are not authorizing a Supplemental Examiner's Answer under 37 CFR § 1.193(b)(1). Ex parte Zambrano, 58 USPQ2d 1312, 1313 (Bd. Pat. App. & Int. 2001).

Summary

The claims, properly construed, do not read on the compositions disclosed in the cited prior art. We therefore reverse the rejections for anticipation. We vacate the rejection for obviousness, because the examiner has not considered all of the limitations of the claims and shown that all of those limitations would have been rendered obvious by the prior art. We remand the application for further action consistent with this opinion.

REVERSED-IN-PART, VACATED-IN-PART, REMANDED


Sherman D. Winters

Administrative Patent Judge


Demetra J. Mills

Administrative Patent Judge


Eric Grimes

Administrative Patent Judge

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